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10/697,256	10/31/2003	Kazuo Okada	SHO-0054	9221		
23353	7590	04/14/2008	EXAMINER			
RADER FISHMAN & GRAUER PLLC LION BUILDING 1233 20TH STREET N.W., SUITE 501 WASHINGTON, DC 20036				SHAH, MILAP		
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**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

<b>Office Action Summary</b>	<b>Application No.</b>	<b>Applicant(s)</b>	
	10/697,256	OKADA, KAZUO	
	<b>Examiner</b>	<b>Art Unit</b>	
	Milap Shah	3714	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

#### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

#### Status

1) Responsive to communication(s) filed on 02 January 2008.

2a) This action is **FINAL**.                            2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

#### Disposition of Claims

4) Claim(s) 17-23 is/are pending in the application.

4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.

5) Claim(s) \_\_\_\_\_ is/are allowed.

6) Claim(s) 17-23 is/are rejected.

7) Claim(s) \_\_\_\_\_ is/are objected to.

8) Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

#### Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on \_\_\_\_\_ is/are: a) accepted or b) objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11) The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

#### Priority under 35 U.S.C. § 119

12) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a) All    b) Some \* c) None of:

1. Certified copies of the priority documents have been received.
2. Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

#### Attachment(s)

1) Notice of References Cited (PTO-892)

2) Notice of Draftsperson's Patent Drawing Review (PTO-948)

3) Information Disclosure Statement(s) (PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.

4) Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_.

5) Notice of Informal Patent Application

6) Other: \_\_\_\_\_.

## **DETAILED ACTION**

This action is in response to the amendment received on January 2, 2008. The Examiner acknowledges that claims 17, 18, & 22 were amended, no claims were canceled, and claim 23 was added. Therefore, claims 17-23 are currently pending.

### ***Claim Objections***

Claim 17 is objected to because of the following informalities: At line 12, the phrase "price-winning" should be "prize-winning". Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

Claims 17-23 are rejected under 35 U.S.C. 103(a) as being unpatentable over Nishikawa (JP Publication No. 2000-300729) in view of Ishida (JP Publication No. 09-253271). [Note: A machined English translation is provided for Ishida. A translation of Nishikawa is of record.]

**Claims 17 & 23:** Nishikawa discloses the invention substantially as claimed including a gaming machine comprising:

a plurality of variable display devices (figures 1 or 3[variable reel drums 2] and paragraph 0002);

a stop control device for performing stop control of the plurality of variable display devices in response to a stop operation via a plurality of stop buttons, each of the stop buttons

corresponding to each of the variable display devices (figure 2[control section 18 including a transducer 22 to control a motor for driving the reels in accordance with the game being played, such that the ‘stop control device’ is used to stop the spinning of reels in response to stop buttons as described in paragraph 0002]);

a lottery device for executing a lottery of a prize-winning combination (figure 2[CPU 18], where the CPU of a gaming machine utilizes a random number generator to generate a random lottery outcome); and

a shielding device for shielding the variable display devices and an attraction display device for displaying predetermined attraction images thereon (Nishikawa discloses an LCD layer disposed in front of the variable reels, where the LCD is able to perform the task of a shielding device, where the reels are either shielded or shown and perform the task of an attraction display device, where images are displayed on the LCD for attraction purposes).

Nishikawa lacks the following:

(1) the shielding device and the attraction display device being two separate devices or components, where the attraction display device is disposed in front of the shielding device; and

(2) the lottery device selecting one stop order from a plurality of stop orders in a stop order table, where a lottery outcome device facilitates the entering or carrying out of the selected stop order associated with the prize-winning combination, further, where the shielding device shields other variable devices than one variable device which is to be firstly stopped, and further shielding other variable devices than another display device to be subsequently stopped. Lastly, as part of this process, Nishikawa also lacks a determining device for determining whether or not the order of the stop control has been performed in a correct order. In summary, Nishikawa lacks shielding the variable devices in the order in which they should be stopped by a player (i.e. if the stop order

table selects the order of 3-1-2, the third variable display is to be stopped first, thus, variable display device 1 and 2 would be shielded, next variable device 2 would only be shielded such that variable display device 1 can next be stopped, and so on). It is understood, the determining device merely confirms the correct stop order is performed.

As to point (1) above, Regardless of this deficiency, the Applicant is directed to *In re Dulberg*, 289 F.2d 522, 523, 129 USPQ 348, 349 (CCPA 1961) [see also MPEP 2144.04, section V, part C]. Summary of *In re Dulberg*: "The claimed structure, a lipstick holder with a removable cap, was fully met by the prior art except that in the prior art the cap is 'press fitted' and therefore not manually removable." The court held that "if it were considered desirable for any reason to obtain access to the end of the prior art's holder to which the cap is applied, it would be obvious to make the cap removable for that purpose." The Examiner submits the same logic is applicable to the instant case as Nishikawa provides a similar invention, with the simple difference that Nishikawa performs two tasks with a single device (i.e. the transparent liquid crystal display performs both shielding and displaying of attraction images) and the instant application claims the same two tasks performed by two separate devices. Therefore, if it were desirable for any reason to perform such tasks by two separate devices, it would be obvious to one of ordinary skill in the art to use two separate devices for such a reason (i.e. the Applicant discloses that in Nishikawa it is difficult to display images effectively if both tasks are performed by a single device). For the purposes of patentability, making a single device separable into two devices is not considered to be patentably distinct. Therefore, it would have been obvious to one of ordinary skill in the art at the time of the invention to modify Nishikawa to make the disclosed single display device separable into two devices effectively producing a shutter or shielding device and a separate image attraction display device for at least the reason that it may have been desirable to one of ordinary skill in the art for at

least the purpose of providing a special-purpose device for shielding and a special-purpose device for displaying attraction images so that extensive imaging be utilized on the attraction image device without the necessity to manage shielding simultaneously.

As to point (2) above, the Examiner submits Ishida discloses a gaming machine in which a validation order selection means randomly selects one of two stored stop orders and conducts a game in which the player is directed to stop the reels in either of the two orders. Depending on the selected stop order from the stop order table, the player is able to only stop one variable display device at a time and the variable display device to be stopped is indicated to the player via an indication lamp associated with the stop button for that particular variable display device. Thus, Ishida discloses a teaching in which a plurality of variable display devices are spinning and are to be stopped in accordance with a randomly selected stop order from a stop order table. Ishida's game controller also performs the task of the determination device for determine whether or not the order of the stop control has been performed in the correct order, as it appears pressing an incorrect stop button will not stop the associated variable display device unless it is to be stopped, thus, there is an implicit determination of reach an end having a correct order of stoppage. Further, given the established structural elements of Nishikawa as modified and described above, it would have required mere routine skill in the art to use the shielding device to shield those reels that are not be stopped and make visible the variable display that is to be stopped based on the stop order selected as taught by Ishida. Ishida discloses an indication lamp or light for indicating that a particular variable display device is to stopped, however, as a mere design consideration, using the structure of Nishikawa, rather then an indication lamp, one of ordinary skill in the art would have found it obvious to use the shielding device for the same purpose of indicating to the player that a particular variable display device is to be stopped based on the selected stop order. To be clear, it is

noted, the only difference between the Applicant's functional language directed to how the shielding devices operate with respect to a selected stop order table is that Ishida does not disclose shielding of these variable devices, however, there is an implicit guard against being able to select variable devices that are not to be stopped yet. At this point, as described above, it's a mere design consideration to mask those reels that simply cannot be stopped until their "turn" comes up based on the stop order table selected. Nishikawa is clearly capable of performing such a function. It also appears the To provide motivation, the Examiner submits that the combination of Nishikawa and Ishida would improve upon older mechanical gaming machines in which it is well known in the art that certain players can be so skilled to stop mechanical reels at desired positions to obtain high awards (i.e. considered cheating in casinos), thus, to avoid this type of skilled play, it would have been desirable to completely shield or mask variable display devices that are not to be stopped yet, as these skillful players use information as to what is happening on each variable display device to attempt to obtain a desired stopping position. Therefore, it would have been obvious to one of ordinary skill in the art at the time the invention was made to modify Nishikawa (as modified with two LCD panels, with respect to point (1) above) to first select a stop order from a stop order table, then shield the reels that are not to be stopped based on the selected stop order as taught by Ishida for at least the reasons discussed above. See at least abstract, figures 3-6, and paragraphs 0027-0036 of Ishida. This is representative of Ishida's teachings, thus, the Applicant is requested to review the entire disclosure when preparing a response to this office action.

It also appears the functional language throughout discussion of what the shielding device performs (i.e. within the three wherein clauses at the end of claim 17), also includes the attraction display device displaying attraction images or other images corresponding to the game, such as overlaying game features or game symbols on top of what is displayed through the shielding

device. Nishikawa discloses attraction imaging, for at least the purpose of highlighting wins and displaying other gaming features superimposed on top of what the variable display devices show, thus, it would be obvious to maintain this operation of Nishikawa even if the LCD panel is modified into two LCD panels, one specifically for attraction imaging, and one specifically for shielding as described above. Additionally, the superimposing of attraction imaging on top of variable display devices as described is well known in the art and many evidentiary references are cited of record in this application (See Loose et al. of record).

The Examiner notes the Applicant's response to functional language recitations in the response received January 2, 2008. The Examiner maintains that the "for" language in at least claims 17-22 is directed to functional language; the language describes the invention by what the various devices/components do rather than what they are. Functional language is considered the describing of an apparatus element by what the element does, rather than what the element is. The Applicant's response even appears to support this assertion, as it states "Indeed, the functional language in the present invention defines the claimed features by what they do rather than what the claimed features are." Thus, even the Applicant appears to be indicating the "for" language is intended use. Further for example, if additional structure is defined by a wherein clause, the wherein clause is not considered functional, but, when the wherein clause merely recites one possible way to use the apparatus element/component, that language is essentially functional only. Thus, the three wherein clauses at the end of claim 17 are considered functional language as they recite one possible function of the shielding and attraction devices, rather than further limiting how these devices are structurally. Nonetheless, the Examiner appears to have addressed the functional language recited in at least claim 17 above.

Regarding claim 23, the Examiner acknowledges the Applicant's use of "means for", which appears to invoke 35 U.S.C. 112, 6<sup>th</sup> paragraph. Thus, the Examiner must show an equivalent means for each of the recited elements. The Examiner submits that the means for (1) performing stop control, (2) executing a lottery, (3) designating a correct order, and (4) determining whether the stop order control has been performed, is merely a microprocessor or CPU that controls the software on the gaming machine to carrying out these processes. The combination of Nishikawa & Ishida above disclose a gaming machine in which a CPU or microprocessor performs these tasks. Nishikawa & Ishida also disclose an equivalent means for displaying various symbols, such as via variable display devices controlled by a motor, software, and a microprocessor. Lastly, the combination of Nishikawa & Ishida also disclose an equivalent means for both shielding and displaying attraction images, such as via a shielding device and an attraction display device as described herein above. As the Examiner appears to have addressed the three wherein clauses of claim 17, and those of claim 23 are equivalent, claim 23 is rejected on the same grounds as claim 17, where equivalent "means for" are described above.

Therefore, for at least all of the reasons provided, claims 17 & 23 are rejected as being unpatentable over the combination of Nishikawa & Ishida.

**Claims 18 & 19:** Nishikawa's liquid crystal display is considered an electronic shutter, as the display is a video display and "shutters" or blocks visibility of symbols via a colored or opaque state and enables visibility via a transmissive or semi-transmissive state. Additionally, as discussed above, it would have been obvious to make that separate electronic shutter device specifically for shielding.

**Claim 20:** As is the nature of electronic shutter devices (i.e. transparent liquid crystal displays), the shielding state being opaque and transparent is controlled by way of an applied voltage (figure 2).

**Claim 21:** As discussed before and now inclusive within the established separable tasks of shielding and displaying attraction images, Nishikawa discloses the structure of the liquid crystal display capable of being controlled by a “special games control device” (i.e. a portion or program within the game controller) for providing a special games state under a predetermined condition, where the attraction control device controls the shielding device during the special gaming state to display such arrangements as a bonus game (i.e. a special game), overtop the variable display device.

**Claim 22:** As described above, the limitation of claim 22 is considered an intended use limitation such that the limitation refers to the functions of the attraction control device versus modifying the structure of the device. Thus, the Examiner submits for purposes of patentability the appropriate structural components were described above and the remainder of claim 22 refers directly to the intended use of said devices, which are considered to be capable of performing said functional operations. See “Examiner’s Note” above.

#### ***Response to Arguments***

Applicant's arguments with respect to claims 17-23 have been considered but are moot in view of the new ground(s) of rejection.

A response to the Applicant's discussion of functional language is included in the new rejections set forth above.

Lastly, it should be noted that the Applicant amended claim 17 to add at least one additional limitation and added a new claim 23. Thus, this action is properly made final.

***Conclusion***

Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Milap Shah whose telephone number is (571)272-1723. The examiner can normally be reached on M-F: 9:30AM-6:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Robert Pezzuto can be reached on (571) 272-6996. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Robert E Pezzuto/  
Supervisory Patent Examiner, Art Unit 3714

/MBS/